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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,590	03/25/2004	Yoshihisa Kubo	26B-032	4605
23400	7590	05/02/2006		
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			EXAMINER CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,590

Applicant(s)

KUBO ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006 and 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

RESPONSE TO AFTER FINAL

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action, mailed March 20, 2006, is persuasive and, therefore, the finality of that action is withdrawn. In view of the wrong action being mailed, the Office Action mailed March 20, 2006 is vacated and a new response based on Applicant's response filed December 20, 2005 is set forth below.
2. Claims 1-13 are pending in the application; claims 8-13 have been withdrawn from consideration.
3. Amendments to the claims, filed on December 20, 2005, have been entered in the above-identified application.

REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 102

5. Claims 1, 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima et al. (U.S. Patent No. 6,395,355).

Nakajima discloses a weather strip (*title*) having an extrusion portion (*extruded product, col. 7, line 43*) and a molded portion (*molded part, col. 8, line 54*) connected to the extrusion portion (*figures 2-6*). The weather strip comprises a mounting base portion (*back part of sealing*

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portion, figure 7), a seal portion (*col. 8, line 55*) that is integrally formed with the mounting base portion and has a hollow portion (*figures 2-6*), a slit formed in the mounting base portion of the molded portion (*figure 11*), and at least one blocking piece (*molded part, col. 8, line 54*) which is integrally formed with the mounting base portion at a side of the base portion that is opposite the seal portion and wherein the blocking piece is located in a zone in which the slit is formed. The blocking piece comprises a base piece formed in such a manner as to extend an attachable mounting surface of the mounting base portion of the molded portion, an insertion portion integrally formed in such a manner as to extend substantially perpendicularly from the base portion and a lock portion (*col. 8, lines 61-62 and figures 2-6*).

The limitation “attachable to one of a door peripheral portion and an opening portion of a vehicle” is deemed to be a recitation that an element is “capable of”. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform.

The limitation “for taking out a core mold” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The limitation “when performing molding” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

Claim Rejections - 35 USC § 103

6. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al. (U.S. Patent No. 6,395,355).

Nakajima is relied upon as described above.

Nakajima fails to disclose that the blocking piece forms a z or y shape.

It would have been an obvious matter of design choice to change the shape of the blocking piece, since a modification would have involved a mere change in shape of the blocking piece. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments in the response filed January 27, 2006 regarding the rejections of record of record have been carefully considered but are moot in view of the new rejections.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

4/28/06



ALICIA CHEVALIER
PRIMARY EXAMINER